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18 *Attorneys for Plaintiff*
19 ORACLE AMERICA, INC.

20 **UNITED STATES DISTRICT COURT**
21 **NORTHERN DISTRICT OF CALIFORNIA**

22 **SAN FRANCISCO DIVISION**

23 ORACLE AMERICA, INC.

Case No. CV 10-03561 WHA

24 Plaintiff,

**ORACLE AMERICA, INC.'S MOTION IN
LIMINE CONCERNING TESTIMONY BY
JONATHAN SCHWARTZ**

25 v.

26 GOOGLE, INC.

Dept.: Courtroom 8, 19th Floor
27 Judge: Honorable William H. Alsup

Defendant.

1 Oracle moves to preclude Google's future use of certain testimony given by Jonathan
 2 Schwartz concerning whether Sun had made any decision to sue Google while he was CEO. Mr.
 3 Schwartz's testimony on this issue (i) has no legal nor factual predicate, (ii) raises issues irrelevant to
 4 Phase 2 and 3 of the case; and (iii) is otherwise inadmissible on Rule 403 and 701 grounds.¹

5 Google referenced such testimony in its Closing Statement for Phase 1 and appears poised to
 6 rely upon such statements again in Phase 2 as Mr. Schwartz appears on Google's most recent
 7 "rolling" list of witnesses. Because Google's reliance on Mr. Schwartz's testimony is impermissible,
 8 Oracle seeks the following relief: (i) that for Phases 2 and 3 of the trial, the Court preclude Google
 9 from making any reference to or argument based on, or eliciting any further testimony regarding, the
 10 purported legal opinions and conclusions that Jonathan Schwartz offered in his testimony in Phase 1
 11 of the trial, RT at 2002:5-7, and (ii) that the Court instruct the jury that it should disregard that
 12 testimony in Phases 2 and 3 of the trial.

13 Late in its Phase 1 case in chief, on Thursday, April 26, Google called former Sun CEO
 14 Jonathan Schwartz as a witness. Google's counsel concluded his direct examination with the
 15 following:

16 Q. Mr. Schwartz, as CEO of Sun, did you make a decision not to pursue litigation against
 17 Google over Android?
 18 A. Yes. We didn't feel we had any grounds.

19 (RT at 2002:5-7.) Google's question called for a yes or no answer, but Mr. Schwartz in response
 20 volunteered an opinion as to what "we" "felt" about the grounds for pursuing litigation against
 21 Google over Android. Google's counsel referred to this testimony by Mr. Schwartz in Google's
 22 closing argument to the jury (RT at 2519:19-21) and also cited this testimony in Google's proposed
 23 findings of fact. (Dkt. 1047 at p. 23 ¶ 72.)

24 The question appeared to ask only whether Mr. Schwartz had made a decision not to pursue
 25 litigation. But Mr. Schwartz's answer – and Google's subsequent use of that answer – implicates
 26 Sun's (now Oracle's) privileged discussions by suggesting that there was an unidentified group of

27 ¹ This motion is being filed outside of the normal evening briefing schedule. Of course, Google's
 28 response deadline would also be outside of that schedule. We look forward to discussing this
 motion with the Court as the Court may direct.

1 people (“we”), who had made some final decision as to whether to pursue litigation and the strength
2 of those claims. What legal grounds Sun’s management felt they had or what decisions they were
3 considering is clearly privileged. Moreover, Mr. Schwartz had no right nor any basis to make such a
4 statement which subjects Oracle to privilege waivers that Mr. Schwartz has no authority to invoke.
5 Further, the suggestion that Oracle had decided not sue is clearly against the weight of the evidence
6 presented in this case. Any attempt by Oracle to rebut such a statement at the time of Mr. Schwartz’s
7 testimony would have put Oracle in the quandary of having to decide whether to waive privilege on
8 the spot to rebut his testimony.

9 Oracle does not seek to re-litigate the issues presented in Phase 1. Nonetheless, the same jury
10 will be asked to render decisions in Phases 2 and 3. Oracle is concerned that Google will argue in
11 both opening statements and closing arguments that Mr. Schwartz’s purported decision not sue and
12 his purported opinions about “grounds” for a lawsuit, are relevant to the issues that the jury must yet
13 decide. They are not.

14 First, Mr. Schwartz’s testimony is simply untrue, to the extent that it is offered to suggest that
15 Sun, the company, had made an affirmative decision not to sue Google over Android. Phase 1
16 evidence demonstrated that there were ongoing discussions between Sun and Google after Google’s
17 announcement of Android in November 2007, that those discussions continued after Oracle acquired
18 Sun in 2010, and that those discussions in fact never stopped. (TX 2371, 1056, 2070, 2362; RT at
19 492:18-22 (Page) (“Continue to have discussions to this day” with Sun); RT at 1071:23-1073:9
20 (Cizek) (Sun expressed infringement concerns in April 2009)). The tenor of the discussions was such
21 that Mr. Schmidt testified that he was sufficiently concerned about Sun suing Google that he
22 considered buying all the rights to Java from Sun to “make Java lawsuits go away” (RT 1516:13-
23 1517:11 (Schmidt)); others at Google expressed similar concerns. (TX 326, 406, 1029.) If Google is
24 allowed to rely on this testimony, and the jury is allowed to believe that it matters, the trial will divert
25 into an irrelevant sideshow over Mr. Schwartz’s subjective state of mind, instead of Sun’s affirmative
26 acts.

27 Second, Mr. Schwartz’s testimony about his subjective state of mind – his purported decision
28 not to sue – is irrelevant to any of the remaining issues that the jury will decide: patent infringement,

1 damages, and willfulness. Google cited this testimony as relevant to its equitable defenses (Dkt.
 2 1047 at p. 23 ¶ 72), but what Mr. Schwartz “felt” about Sun’s claims against Google has no bearing
 3 on any of Google’s defenses. This is particularly true in light of Mr. Schwartz’s testimony that “I
 4 don’t think I’m qualified to speak as a lawyer” and that “I’m not there to write our contracts.” (RT at
 5 2014:10-2015:11.) Waiver, along with all of Google’s other defenses, requires an affirmative act by
 6 Sun to abandon its rights, not merely a failure to act or even a decision not to act for some period of
 7 time. *See United States v. King Features Entm’t, Inc.*, 843 F.2d 394, 399 (9th Cir. 1988); *Adidas*
 8 *America, Inc. v. Payless Shoesource, Inc.*, 546 F. Supp. 2d 1029, 1074 (D. Or. 2008). Google cannot,
 9 in good faith, argue that Mr. Schwartz ever *told* Google that he had reached such a decision (in fact,
 10 he testified at deposition that he had not, *see* Schwartz Dep. at 140:23-141:1), and no witness, from
 11 Google, from Oracle, or anywhere else, has ever claimed otherwise. As a result, Mr. Schwartz’s
 12 testimony on this point is simply irrelevant to all issues in the trial.

13 Third, Mr. Schwartz’s testimony that “We didn’t feel we had any grounds” is an inadmissible
 14 opinion. Rule 701 permits opinion testimony only where the testimony is “rationally based on the
 15 witness’s perception” and “not based on scientific, technical, or other specialized knowledge within
 16 the scope of Rule 702.” If Mr. Schwartz expressed a personal opinion, it is both incompetent and
 17 irrelevant. Mr. Schwartz is not a lawyer, and even if he were, it is the province of the jury to find
 18 facts, not decide whether claims have a legal basis. Mr. Schwartz is not an engineer or an attorney,
 19 and he had no ability to assess the merits of any legal claims against Google over Android in either a
 20 technical or legal aspect. In fact, as noted above, he expressly admitted that fact in his trial
 21 testimony.

22 If instead Mr. Schwartz’s testimony is understood as expressing a conclusion of Sun’s
 23 lawyers, it should be excluded because Google failed to lay any foundation for that testimony, and
 24 Oracle cannot disprove it, without waiving privilege to Oracle (and Sun’s) internal analyses of its
 25 legal claims. Mr. Schwartz has no right to waive Sun’s privilege, or to put Sun’s privileged
 26 communications at issue. In short, Mr. Schwartz’s comments were both baseless and inappropriate,
 27 and their admission in either or both subsequent phases of this trial would severely prejudice Oracle.
 28 *See* Fed. R. Evid. 403.

1 Fourth, Mr. Schwartz's testimony in Phase 1 concerned copyrights, not patents. Even if that
2 testimony were proper and admissible – and for the reasons stated above, it is not – there is no basis
3 in that trial testimony to conclude that Mr. Schwartz ever evaluated Sun's patent claims or was
4 capable of doing so, that he had made any effort to do so, or that he ever made any decision whether
5 or not to sue on those particular claims. Indeed, there is no evidence in the record that even indicates
6 when Mr. Schwartz supposedly made his personal decision not to sue Google over Android. As a
7 result, there is no foundation to establish the relevance of Mr. Schwartz's testimony to Phase 2 or 3.

8 If Google intends to argue that Mr. Schwartz waived Sun's right to sue, it must come forward
9 with evidence of waiver and give Oracle a full and fair chance to rebut such evidence. Forcing
10 Oracle into the position of rebutting innuendo when the means of fighting such a suggestion involve
11 either calling others in Sun's top management who do not appear on the witness list and possibly
12 partially waiving privilege over certain discussions is untenable.

13 Oracle brings this motion now because it cannot know how Google will try to use Mr.
14 Schwartz's Phase 1 testimony, or whether Google will call Mr. Schwartz again. If Google simply
15 waits until its closing in Phase 2 or 3 to trot out Mr. Schwartz's opinions, Oracle will not have an
16 opportunity to rebut those claims with evidence. Further, if Google refuses to say whether it will try
17 to use that testimony in Phase 2 or 3, Oracle must make an uninformed decision whether to spend its
18 valuable trial time, and whether to waive privilege, just in case Google repeats its Phase 1 strategy.

19 Oracle maintains that Mr. Schwartz's unanticipated and improper testimony on this specific
20 issue is irrelevant, inadmissible, prejudicial, and would unfairly require Oracle to waive privilege to
21 fully cross-examine and rebut. It should be excluded from all further phases of the trial, and the jury
22 should be expressly instructed to disregard it.

23 Nonetheless, if Google is allowed to use that testimony or elicit further testimony along the
24 same lines, or if the jury is allowed to consider it in any way, Oracle must be given fair notice and a
25 fair chance to rebut. Oracle can prove Mr. Schwartz's testimony false, and is prepared to do so, by
26 offering testimony from other Sun executives, including executives who were not previously
27 disclosed as witnesses. If necessary, Oracle may have little choice but to make a partial waiver of
28 privilege. That is not the result Oracle seeks, nor would it avoid prejudicing Oracle. But if Google

1 persists with the strategy that it used in Phase 1, Oracle must be allowed at least that much
2 opportunity to set the record straight.

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5 Dated: May 3, 2012

BOIES, SCHILLER & FLEXNER LLP

6 By: /s/ Steven C. Holtzman
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